

### **AMENDMENTS TO THE DRAWINGS**

Please replace Figures 2, 2a, and 2b with the two enclosed clean replacement drawing sheets that are amended to cancel new matter. Please replace Figure 8 with the enclosed clean replacement drawing sheet amended to add a label for mortise member 100.

## **REMARKS**

**Specification.** The Examiner indicated confusion regarding the Specification. Applicant has amended the specification for clarification by simplifying descriptors of the word “member.” New matter added in Applicant’s March 26, 2007 Response is canceled, and no new matter is added.

**Drawings.** The Examiner objected to some of the drawings. Applicant has amended the drawings and submits three replacement drawings containing four figures in compliance with 37 CFR §§1.84 and 1.121. Figures 2, 2a, and 2b are amended to cancel the new matter added in the March 26 Response. Figures 2b and 8 are also amended to add a label for mortise member 100. Figure 2b was added in the March 26 Response, but does not contain new matter. Figure 2b merely illustrates the combination of members 100 and 200 and panel 1000 that was described in the original paragraph [5].

**Claims.** The Examiner correctly pointed out that Applicant submitted canceled claims without deleting the text. Applicant has corrected this oversight in the claims herein submitted. Applicant has canceled claims 1-10 and 13, amended claim 11, and added claim 14, a combination of the limitations of prior claims 1 and 11 into a claim made more narrow with the limitation of a two-piece mortise.

**Rejections.** Examiner’s §112 rejection of claims 1 and 11 is somewhat confusing. Applicant submitted amendments of claims 1 and 11 in his March 26 Response. In her subsequent Office Action, Examiner rejected claim 1 based on its original form, and claim 11 based on its amended form. Examiner contends that claim 1, recited in its original unamended form, is unclear as to whether the first members are interlocked with a mortise and tenon joint, or if the first members are interlocked with a second member using a mortise and tenon joint. The only mention of a mortise and tenon joint is in the first part of amended claim 1 in which is described a system of first members interlocked with each other. The second part of claim 1 enlarges the system with an assembly of said interlocked (and, possibly, said uninterlocked) first members into an assembly named “second member.” That second member then receives a panel.

Applicant, in an effort toward clarification of the types of members claimed and described, has amended out the descriptor “second,” and now relies on “first,” “intermediate,” “mortise,” and “frame” to distinguish among members of the present invention. Applicant has also provided antecedent basis for the use of “first member” and “frame member” in the amended claims. Those amendments do not add new matter; rather, they merely add descriptors to original references to “member.” Applicant respectfully submits that the smaller claim set and the Description amendments clear any confusion about members that comprise the present invention.

Applicant hopes his amendments alleviate Examiner’s confusion regarding claim 11. The novelty in claim 11, in fact the major novelty of the present invention, is that the claimed mortise, unlike a conventional mortise, is made of two parts. Although it is a two-piece, rather than a one-piece object, the mortise of claim 11 is still but one part of the claimed joint. The two-piece mortise, as are all mortises, must be configured to receive some kind of a tenon. The “configured to” phrase is a descriptive limitation. A mortise is not really a mortise, and is in fact useless, unless it is configured to receive a tenon. Claim 11 merely recites that the tenon captured by the claimed mortise is the said tenon for which said mortise is configured. The claim is indeed for a matching mortise-tenon combination.

Applicant’s mortise is novel because it is made of two pieces. The claim 11 mortise “[captures] said tenon,” as it must to perform its useful function. The two-piece mortise gives the user the ability to disassemble the mortise *in situ*, thereby releasing the tenon without the necessity of sliding the tenon lengthways out of the mortise, an action that would require complete dismantling of the framework holding the panels. Applicant’s novel, two-piece mortise permits a user to “uncapture” the tenon in a direction perpendicular to the mortise-tenon long axis.

The Examiner also rejected claims 1 and 11 as being anticipated by Lew (US 4652170). Applicant respectfully contends that the combination of claim 11 (the two-piece mortise) and claim 1 into a single claim overcomes the 35 USC §102 rejection because Lew does not claim or describe Applicant’s invention in its amended claim set. Applicant has canceled all claims for a space-partitioning system that might read on Lew.

Examiner is incorrect in asserting that Applicant's two-piece mortise is anticipated by Lew. Lew nowhere claims, describes, or illustrates a two-piece mortise. Examiner points to Lew's Figures 21 and 22 for examples, but both figures show a one-piece mortise. Lew's feature 87 in Figure 22 is clearly described (Lew, column 6, line 29) as a groove on the one-piece mortise bar 85 that can receive the male dovetail feature 84 on the one-piece tenon rail 84 (Lew, column 6, line 32).

The basic disputed issue is Examiner's contention that Applicant's claimed mortise is not made of two pieces because Applicant uses the word "member" rather than "piece." Examiner's claim construction is incorrect. In her interpretation of Lew, Examiner uses "member" where "feature" is more appropriate. With hindsight Applicant concedes his original draft could have been more artful, but it repeatedly and consistently used "member" to refer to a distinct object; thus making it interchangeable with "piece." Most of Applicant's Specification amendments in his March 26 Response were directed toward making clear distinction among first, second, and intermediate members, and it is hoped that the amendments submitted herein strengthen that effort.

Examiner calls each feature or facet of one of Lew's beams a "member," contrary to Lew's own terminology. In his Abstract, Lew twice mentions a "threaded cylindrical locking member," and describes that member as "the locking screw 45 shown in FIG. 11 or the locking plug 56 shown in FIG. 14..." Lew, column 6, lines 39-41. The referenced figures and Lew's figure 10 clearly show that the "member" has several features (such as washer 48, countersunk head 46, socket 47, extremity 49, etc.) that, in her terminology, Examiner would call "members," just as she incorrectly labels the male corner features "A" and the female dovetail groove 88 in Lew's figure 22 (as annotated on page 7 of the Office Action). Features "A" and 88 are not "members" even in Lew's own terminology.

The question of what sources should be consulted by a person of skill in the relevant art for understanding disputed claim language has been settled by the Federal Circuit. Other than the claims themselves, in descending order of preference, those sources are "the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant principles, the meaning of technical terms, and state of the art." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314

(Fed.Cir.2005), citing *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.* 381 F.3d 1111, 1116 (Fed.Cir.1995).

Looking first to Applicant's claims, as ordered by *Phillips*, "members" in claim 1 clearly refers to objects each having "a plurality of surfaces." Had Applicant used Examiner's language, claim 1 would have read "an object having a plurality of members." And Applicant has herein amended claim 11 so that it refers more specifically to two first members, as opposed to previously mentioned interlocked members or first members assembled into second members. Furthermore, Figure 1, the illustration of the preferred embodiment of the claim 11 device, shows two separate, distinct, and individual first members comprising the claimed mortise.

But in claim construction, claims alone are often not sufficient, and *Phillips* cites Judge Rich for the relationship between claims and the Description: "[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims." *Phillips* 415 F.3d at 1315, citing *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed.Cir.1985). The *Phillips* court went further:

Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction."

*Phillips* 415 F.3d at 1316, citing *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed.Cir.1998).

Applicant's original Specification could have given rise to confusion because some "members" were comprised of one part, or piece, and others were comprised of two parts. Nevertheless, none of the members were mere features or appendages of some other object; they were all distinct objects. Applicant's March 26 amendments merely differentiated among members with the descriptors "first," "intermediate," and "second" applied to those distinct objects. However, currently amended paragraph [04] is one example of Applicant's current clarifying amendments: "FIG.1 is an end view of one embodiment of a mortise member 100 comprised of first

members 1 and 4 of the present invention.” Members 1 and 4 together form member 100, as clearly shown in figure 1, yet all three members are distinct, individual objects, rather than appendages or features. The same cannot be said about features “A” and groove 88 in Lew’s figure 22.

Applicant respectfully submits that his Specification expressly defines “member” as a distinct object. However, even an implied definition is sufficient for an Applicant acting as his own lexicographer. The Specification is “the single best guide to the meaning of a disputed term,” and “acts as a dictionary when it expressly defines terms used in the claims or when it defines terms *by implication*.” *Phillips* 415 F.3d at 1321, citing *Vitrionics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996) (emphasis added).

The *Phillips* court summarized its findings as follows: “Consistent with that general principle, our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs.” *Phillips* 415 F.3d at 1316. However, in this case, it is not the Applicant who is using a definition of a term that differs from its usual meaning. By calling each feature or facet of one of Lew’s beams a “member,” Examiner is attempting to impose her lexicography on Applicant’s claims. In doing so Examiner is using the second preferred dictionary definition of “member” as “a part, as an organ or limb, of a person, animal, or plant.” In contrast, Applicant is using the first preferred dictionary definition of “member” as “a distinct part of a whole” where “distinct” is defined as “distinguished from all others: individual.” WEBSTER’S II NEW RIVERSIDE DICTIONARY, revised edition, 1996. Therefore, even the least determinative factor in claim construction, extrinsic evidence such as dictionaries (see the *Innova* citation, *supra*), weighs heavily in support of Applicant’s lexicography over that of the Examiner.

The distinction is critical as well as distinguishing. Lew’s structure is not capable of performing the functions performed by Applicant’s invention. Applicant’s novel two-piece mortise permits the user to capture and secure a panel that has no special edge treatment. In contrast, Lew’s system of one first member and one second member requires that each board or panel that is to be made part of his furniture has a special built in edge piece (the second member, i.e. member 2 of Lew’s Figure 1; member 36 of Figure 8; member 64 of Figure 16; and member 84 of Figure 21). For

example, Lew describes one second member as “a retaining slide rail 2 affixed to one extremity [of a board].” Lew, column 3, lines 4-6. Lew describes another second member as “a dove-tail shaped retaining slide rail 84 affixed to one extremity [of a board].” Lew, column 6, lines 24-26.

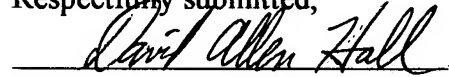
By precluding the need for such custom panel edges, Applicant’s invention makes possible the interchangeability of panels from various and commonly available sources. Plain glass panels from one source can be replaced with plywood from another source without any special edge treatment of the glass or plywood. Such flexibility is a tremendous departure from anything claimed by Lew.

Furthermore, Lew’s system makes it impractical to change panels in certain situations. If, instead of being used on a piece of furniture, Lew’s system were installed to partition a space between two walls, as indicated by Examiner, the panel could not be replaced without removing Lew’s entire system because his second member, with the affixed panel, must be slid lengthwise out of the retaining slide groove (feature 10 of Lew’s Figure 2) in his first member. In contrast, Applicant’s system makes panel replacement easy. For example, it can be seen in Applicant’s Figure 2b that removal of first member 1 or 4 from mortise member 100 permits frame member 200 and panel 1000 to be removed and replaced without having to slide any members lengthways. It is the two-piece mortise of claim 11, absent from any of Lew’s claims, that makes Applicant’s invention novel and significantly more useful than Lew’s.

Examiner correctly states the MPEP §2114 requirement that apparatus claims must be distinguished from prior art by structure. Section 2114 also commands that “Even if the prior art device performs all the functions in the claim, the prior art cannot anticipate the claim if there is any structural difference.” Applicant respectfully submits that the amended claim set distinguishes Lew with the novel two-piece mortise that is undeniably different in both function and structure.

Request. Applicant requests reconsideration and placement of the amended Specification, drawings, and claims in condition for allowance. Applicant would welcome a telephone conference if Examiner believes personal communication would be helpful to prosecution.

Respectfully submitted,

A handwritten signature in cursive script, reading "David Allen Hall", is written over a horizontal line.

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